

ESTTA Tracking number: **ESTTA501007**

Filing date: **10/19/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

### Petitioner Information

Name	Techtronic Power Tools Technology Limited		
Entity	Corporation	Citizenship	British Virgin Islands
Address	Trident Chambers P.O. Box 146 Road Town, Tortola, VIRGIN ISLANDS, BRITISH		

Attorney information	Ariana G. Voigt Michael Best & Friedrich 100 E. Wisconsin Ave. Suite 3300 Milwaukee, WI 53202 UNITED STATES mkeipdocket@michaelbest.com, agvoigt@michaelbest.com Phone:414-271-6560
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### Registration Subject to Cancellation

Registration No	3564511	Registration date	01/20/2009
Registrant	Magma Diamond Tools 1325 S. International Pkwy, Suite #1231 Lake Mary, FL 32746 UNITED STATES		

### Goods/Services Subject to Cancellation


Class 007. First Use: 2008/03/01 First Use In Commerce: 2008/04/01  
All goods and services in the class are cancelled, namely: Diamond-pointed metal-cutting tools

### Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act section 2(d)
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### Mark Cited by Petitioner as Basis for Cancellation

U.S. Application No.	85341308	Application Date	06/08/2011
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	FUEGO		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 007. First use: First Use: 2006/02/00 First Use In Commerce: 2006/02/00 Power tools, namely, drills, saws, impact drivers and grinders
Attachments	85341308#TMSN.jpeg ( 1 page )( bytes ) 12037546_MAGMA_FUEGO_Petiton_to_Cancel.PDF ( 11 pages )(243083 bytes )

### **Certificate of Service**

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/ariana g voigt/
Name	Ariana G. Voigt
Date	10/19/2012

	)	
Techtronic Power Tools Technology	)	
Limited,	)	
	)	Cancellation No. _____
Petitioner,	)	
	)	Registration No. 3,564,511
v.	)	
	)	Mark: MAGMA FUEGO
Magma Diamond Tools,	)	
	)	Registration Date: Jan. 20, 2009
Respondent.	)	
	)	

Petitioner Techtronic Power Tools Technology Limited (“Techtronic Power Tools”), a British Virgin Islands corporation having an address at Trident Chambers P. O. Box 146, Road Town, Tortola, British Virgin Islands, believes that it is and will continue to be damaged by U.S. Registration No. 3,564,511 for the mark MAGMA FUEGO for “diamond-pointed metal-cutting tools” (“Respondent’s Goods”) in Class 7 owned by Magma Diamond Tools (“Respondent”) and hereby petitions to cancel the same.

1. Petitioner is a world-class leader in quality consumer, professional, and industrial products marketed to the home improvement, repair, and construction industries.

3. On June 11, 2011, Petitioner filed with the United States Patent and Trademark

Office an application for the registration of FUEGO in connection with Petitioner's Goods.

Petitioner's application for registration of the mark FUEGO is currently pending as Application Serial No. 85/341308 (the "Application"). A print out from TESS setting forth this information is attached as Exhibit A.

4. Petitioner has received an Office Action from the USPTO with respect to its pending application for the mark FUEGO, Serial No. 85/341308, contending that there is a likelihood of confusion between Petitioner's FUEGO mark for Petitioner's Goods and Respondent's MAGMA FUEGO mark ("Respondent's Mark"). A copy of the Office Action is attached as Exhibit B.

5. According to TSDR records, Respondent applied for its MAGMA FUEGO mark on June 16, 2008, and the mark registered on January 20, 2009. Respondent filed a use-based application and claimed a first use in commerce date of April 1, 2008.

6. Petitioner's use of the mark FUEGO in connection with Petitioner's Goods since at least October 2006 predates Respondent's claimed first use in commerce date of April 1, 2008, by almost two years

7. On December 6, 2011, Petitioner wrote to Respondent objecting to the registration of MAGMA FUEGO on the basis of Petitioner's prior use of FUEGO. Respondent has refused to cancel its registration voluntarily.

8. Petitioner is likely to be damaged by the continuing registration of Registration No. 3,564,511 because unless cancelled, the registration will remain as a cloud on Petitioner's legal right to use and register Petitioner's mark FUEGO for use with Petitioner's Goods in

derogation of Petitioner's prior and superior rights.

WHEREFORE, Petitioner requests that Registration No. 3,564,511 be cancelled.

Respectfully submitted,

**TECHTRONIC POWER TOOLS  
TECHNOLOGY LIMITED**

By its Attorneys,

/ariana g voigt/

Date: 10/19/12

Billie Jean Smith

Ariana G. Voigt

MICHAEL BEST & FRIEDRICH LLP

100 East Wisconsin Avenue, Suite 3300

Milwaukee, Wisconsin 53202-4108

Phone: (414) 271-6560

Fax: (414) 277-0656

### **CERTIFICATE OF SERVICE AND MAILING**

I hereby certify that a true and correct copy of the foregoing Petition to Cancel is being served upon Respondent via overnight courier:

Proctor Young  
Magma Diamond Tools  
1325 S. International Pkwy, Suite 1231  
Lake Mary, FL 32746

and that a copy of the same was filed electronically on the same date via ESTTA with the Trademark Trial and Appeal Board.

Date: 10/19/12

/ariana g voigt/  
Ariana G. Voigt

# **EXHIBIT A**



United States Patent and Trademark Office

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# FUEGO

**Word Mark** FUEGO**Translations** The English translation of FUEGO in the mark is FIRE.**Goods and Services** IC 007. US 013 019 021 023 031 034 035. G & S: Power tools, namely, drills, saws, impact drivers and grinders. FIRST USE: 20060200. FIRST USE IN COMMERCE: 20060200**Standard Characters Claimed****Mark Drawing Code** (4) STANDARD CHARACTER MARK**Serial Number** 85341308**Filing Date** June 8, 2011**Current Basis** 1A**Original Filing Basis** 1A**Owner** (APPLICANT) Techtronic Power Tools Technology Limited CORPORATION BR.VIRGIN ISLANDS  
Trident Chambers P.O. Box 146 Road Town, Tortola BR.VIRGIN ISLANDS**Attorney of Record** Billie Jean Smith**Type of Mark** TRADEMARK**Register** PRINCIPAL**Live/Dead Indicator** LIVE[TESS HOME](#) | [NEW USER](#) | [STRUCTURED](#) | [FREE FORM](#) | [BROWSER DICT](#) | [SEARCH OG](#) | [Top](#) | [HELP](#)[HOME](#) | [SITE INDEX](#) | [SEARCH](#) | [eBUSINESS](#) | [HELP](#) | [PRIVACY POLICY](#)



## **EXHIBIT B**

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**To:** Techtronic Power Tools Technology Limite ETC. (  
[mkeipdocket@michaelbest.com](mailto:mkeipdocket@michaelbest.com))

**Subject:** U.S. TRADEMARK APPLICATION NO. 85341308 - FUEGO - 020872-8080

**Sent:** 9/22/2011 2:28:17 PM

**Sent As:** ECOM109@USPTO.GOV

**Attachments:** [Attachment - 1](#)  
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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)  
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION

APPLICATION SERIAL NO. 85341308

MARK: FUEGO

**CORRESPONDENT ADDRESS:**

BILLIE JEAN SMITH  
MICHAEL BEST & FRIEDRICH LLP  
100 E WISCONSIN AVE STE 3300  
MILWAUKEE, WI 53202-4108

**\*85341308\***

**CLICK HERE TO RESPOND TO THIS LETTER:**  
[http://www.uspto.gov/trademarks/teas/response\\_forms.jsp](http://www.uspto.gov/trademarks/teas/response_forms.jsp)

**APPLICANT:** Techtronic Power Tools  
Technology Limite ETC.

**CORRESPONDENT'S REFERENCE/DOCKET  
NO:**

020872-8080

**CORRESPONDENT E-MAIL ADDRESS:**

mkeipdocket@michaelbest.com

## OFFICE ACTION

### STRICT DEADLINE TO RESPOND TO THIS LETTER

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

**ISSUE/MAILING DATE:** 9/22/2011

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issue(s) below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62, 2.65(a); TMEP §§711, 718.03.

### SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION

Registration of the applied-for mark is refused because of a likelihood of confusion with the mark in U.S. Registration No. 3564511. Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.* See the enclosed registration.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely that a potential consumer would be confused or mistaken or deceived as to the source of the goods and/or services of the applicant and registrant. *See* 15 U.S.C. §1052(d). The court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) listed the principal factors to be considered when determining whether there is a likelihood of confusion under Section 2(d). *See* TMEP §1207.01. However, not all of the factors are necessarily relevant or of equal weight, and any one factor may be dominant in a given case, depending upon the evidence of record. *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); *see In re E. I. du Pont*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks, similarity of the goods and/or services, and similarity of trade channels of the goods and/or services. *See In re Opus One, Inc.*, 60 USPQ2d 1812 (TTAB 2001); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593 (TTAB 1999); *In re Azteca Rest. Enters., Inc.*, 50 USPQ2d 1209 (TTAB 1999); TMEP §§1207.01 *et seq.*

### Comparison of the Marks

In a likelihood of confusion determination, the marks are compared for similarities in their appearance, sound, meaning or connotation and commercial impression. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973); TMEP §1207.01(b). Similarity in any one of these elements may be sufficient to find a likelihood of confusion. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1043 (TTAB 1987); *see* TMEP

#### §1207.01(b).

The applicant's standard character mark is FUEGO. The registrant's standard character mark is FUEGO MAGMA. Both marks contain the term FUEGO. The applicant simply delete the term MAGMA from the registrant's mark. The mere addition of a term to a registered mark generally does not obviate the similarity between the marks nor does it overcome a likelihood of confusion under Trademark Act Section 2(d). See *In re Chatam Int'l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004) (GASPAR'S ALE and JOSE GASPAR GOLD); *Coca-Cola Bottling Co. v. Jos. E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105 (C.C.P.A. 1975) (BENGAL and BENGAL LANCER); *Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 153 USPQ 406 (C.C.P.A. 1967) (THE LILLY and LILLI ANN); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266 (TTAB 2009) (TITAN and VANTAGE TITAN); *In re El Torito Rests., Inc.*, 9 USPQ2d 2002 (TTAB 1988) (MACHO and MACHO COMBOS); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) (CONFIRM and CONFIRMCELLS); *In re U.S. Shoe Corp.*, 229 USPQ 707 (TTAB 1985) (CAREER IMAGE and CREST CAREER IMAGES); *In re Riddle*, 225 USPQ 630 (TTAB 1985) (ACCUTUNE and RICHARD PETTY'S ACCU TUNE); TMEP §1207.01(b)(iii).

#### **Comparison of the Goods/Services**

The goods and/or services of the parties need not be identical or directly competitive to find a likelihood of confusion. See *Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975); TMEP §1207.01(a)(i). Rather, they need only be related in some manner, or the conditions surrounding their marketing are such that they would be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that the goods and/or services come from a common source. *In re Total Quality Group, Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999); TMEP §1207.01(a)(i); see, e.g., *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086-87, 56 USPQ2d 1471, 1475-76 (Fed. Cir. 2000); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1566-68, 223 USPQ 1289, 1290 (Fed. Cir. 1984).

The applicant's goods are "Power tools, namely, drills, saws, impact drivers and grinders." The registrant's goods are "Diamond-pointed metal-cutting tools." The registrant's broad identification of goods/services encompasses the goods/services of the applicant. Both parties provide power tools that may be encountered in the same channels of trade. See attached copies of the applicant and registrant's websites. Potential customers may mistakenly perceive that the goods are provided by the same entity.

#### **APPLICANT MAY RESPOND**

Although applicant's mark has been refused registration, applicant may respond to the refusal(s) by submitting evidence and arguments in support of registration.

#### **INFORMALITIES**

If the applicant chooses to respond to the refusal to register, the applicant must also respond to the following informalities.

Please note that the following issues are being raised in this letter in order to address every problem with the application. However, this does not obviate the original determination of non-registrability by the examining attorney. Applicant must still respond to the refusal by submitting arguments in support of registration.

#### **ENGLISH TRANSLATION REQUIRED**

Applicant must submit an English translation of the mark. 37 C.F.R. §2.32(a)(9); TMEP §809.

The following translation statement is suggested:

**The English translation of “FUEGO” in the mark is “FIRE”.**

If applicant has questions regarding this Office action, please telephone or e-mail the assigned trademark examining attorney. All relevant e-mail communications will be placed in the official application record; however, an e-mail communication will not be accepted as a response to this Office action and will not extend the deadline for filing a proper response. *See* 37 C.F.R. §2.191; TMEP §§709.04-.05. Further, although the trademark examining attorney may provide additional explanation pertaining to the refusal(s) and/or requirement(s) in this Office action, the trademark examining attorney may not provide legal advice or statements about applicant's rights. *See* TMEP §§705.02, 709.06.

/Tracy Cross/  
Examining Attorney  
Law Office 109  
Phone: (571) 272-9271  
Tracy.Cross@uspto.gov

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**All informal e-mail communications relevant to this application will be placed in the official application record.**

**WHO MUST SIGN THE RESPONSE:** It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

**PERIODICALLY CHECK THE STATUS OF THE APPLICATION:** To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using Trademark Applications and Registrations Retrieval (TARR) at <http://tarr.uspto.gov/>. Please keep a copy of the complete TARR screen. If TARR shows no change for more than six months, call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

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